

REMARKS

Claims 12-93 will be pending in this application after the Examiner enters the forgoing amendment.

The Examiner objected under 35 U.S.C. § 132 to the preliminary amendment filed April 3, 2000, deeming that the preliminary amendment "introduces new matter into the disclosure"; and claims 14-15, 21-22, 28-29, 35-36, 42-43, 49-50, 56-57, 62-63, 69-70, 75-76, 82-83 and 89-90 rejected under 35 U.S.C. § 112, first paragraph, deeming these claims to contain subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention.

By the instant amendment, applicant has amended claims 12-14, 20, 21, 26-28, 34, 35, 40-42, 47-49, 54-56, 61, 62, 67-69, 74, 75, 80-82, and 87-89.

In pending claim 14, for example, support for the recited devices may be found, for example, in the disclosed cards, such as card 190. "Fig. 11 is a block diagram of customer card 190, including central processing unit 2450, memory 2460 . . . Memory 2460 is a random access, addressable device. . . . Memory 2460 stores a program 2465 executed by processor 2450." Specification, page 18, line 22-page 19, line 4.

In pending claim 15, for example, support for the "telecommunications signal includ[ing] a signal identifying a consumer" may be found, for example in the disclosure of Fig. 18 and checkout counter 900 that "sends redemption data to a market research center. The redemption data sent to the research center includes the identification of the store and of the customers who presented electronic coupons for redemption. The

checkout stations send the redemption data blocks, over telephone signal paths 714." Specification page 25, lines 17-20.

In the course of the objection under 35 U.S.C. § 132, the Examiner stated:

the independent claims covered systems or methods in which customers receive coupons onto non-card portable computing devices (housing) when the original claimed subject matter is cards (190); the housing contains a processing unit that executes a program stored in a random access memory; and the telecommunications signal includes a signal identifying a consumer. (Office Action page 2).

In the course of the rejection under 35 U.S.C. § 112, first paragraph, the Examiner stated:

The above cited claims contain the housing including a processing unit that executes a program stored in a random access memory and the telecommunications signal including a signal identifying a consumer, which were not supported in the original disclosure so that it reasonably deems that the Inventor(s), at the time the original application was filed, didn't have possession of the claimed invention. (Office Action pages 2-3).

Applicant respectfully submits that the claims are fully supported in Applicant's originally filed Application, entitled SYSTEM AND METHOD FOR DISTRIBUTING COUPONS THROUGH A SYSTEM OF COMPUTER NETWORKS. Applicant never stated that cards are essential to the invention. Applicant did state that the "invention relates generally to a retail system and, more particularly, to a system and method for distributing discount coupons through a system of computer networks." Specification page 1, lines 3-4. Applicant also stated that "It is an object of the present invention to provide a convenient and stimulating shopping environment that allows the customer to

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acquire discount coupons through a system of computer networks and to redeem the coupons electronically." Specification page 2, lines 6-8.

The Examiner stated, "the independent claims covered systems or methods in which customers receive coupons onto non-card portable computing devices (housing) when the original claimed subject matter is cards." (Office Action page 2). Although the Examiner's observation regarding the coverage of the pending independent claims is correct, the Examiner's observation is not *ipso facto* relevant to his rejections, as it is axiomatic that "a claim [can be supported] by the specification even though it would be literally infringed by undisclosed embodiments." *Ethicon Endo-surgery, Inc. v. United States Surgical Corporation*, 93 F.3d 1572, 1582 n. 7 (Fed. Cir. 1996).¹

If the Examiner renews his rejection under 35 U.S.C. § 112, first paragraph, Applicant respectfully requests that the Examiner individually identify the claim limitation(s) at issue, and for each provide "reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application."

MPEP 2163.04.

The Examiner rejected claims 12,13,16,17,18,19, 20, 23, 24, 25, 26, 27, 30, 31, 32, 33, 34, 37, 38, 39,40,41,44,45,46,47, 48, 51,52,53,54,55, 58, 59, 60, 61, 64, 65, 66, 67, 68, 71, 72, 73, 74, 77, 78, 79, 80, 81, 84, 85, 86, 87, 88, 91, 92, and 93 under the judicially created doctrine of double patenting over claims 2,2,4,5,6,3,7,8,9, 10, 11, 11,

¹ See Also Office Action pages 4-5 (Examiner deeming the instant independent claims subject to obviousness-type double patenting rejection, and stating "there is deemed to be no significant difference between the housing and card").

13, 14, 15, 12, 16, 17, 18, 19, 20, 20, 21, 22, 23, 24, 24, 25, 26, 27, 28, 28, 29, 30, 31, 32, 33, 34, 35, 36, 36, 37, 38, 39, 40, 41, 42, 43, 44, 44, 45, 46, 47, 48, 48, 49, 50, and 51 of U.S. Patent No. 6,067,526. The Examiner also stated that a terminal disclaimer would overcome this ground of rejection. Although applicant has not evaluated whether the amended application would require such a terminal disclaimer, applicant has enclosed a terminal disclaimer directed to U.S. Patent No. 6,067,526.

If there are any other fees required for entry of this amendment, or for any other reason, please charge such fees to the undersigned attorney's Deposit Account No. 10-0077.

Respectfully submitted,


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